

Remarks

The status of the application is as follows. Claims 1-19 were presented for prosecution, and stand rejected under 35 USC 103(a) over Clark et al., U.S. Patent 5,710,889 ("Clark") in view of Jai et al., U.S. Patent 5,991,402 ("Jai"). Applicant respectfully traverses these rejections for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In the present case, the cited combination of references fails to meet each of the three basic criteria required to establish a *prima facie* case of obviousness.

Initially it is noted that the Office Action appears to be missing portions of the Examiner's arguments at the middle of Page 3 - e.g., the sentence regarding the "institutional server" is incoherent, and there is no discussion regarding Applicant's recitation of a "server provider." Thus, no prior art teaching is alleged for, *inter alia*, the steps of: "storing an encrypted copy of the private data and an unencrypted copy of the public data with an *intermediary service provider*," as recited in independent claim 10; "loading to a client the encrypted private data from the institution and the unencrypted copy of the public data from the *service provider*," as recited in independent claim 14; etc. Clarification is respectfully requested.

Applicant submits that Clark and Jai fail to teach these, as well as other numerous claim features of the present invention. For instance, with regard to claim 1, the Office Action alleges that Clark teaches an institutional server for separately serving a first database of private data and a second database of public data. However, no such distinction is made between private and public data in Clark. Claim 1 further recites "a service provider, wherein the service provider includes a system for receiving an encrypted version of the private data and an unencrypted version of the public data." Clark fails to provide a service provider that receives encrypted private data and unencrypted public data.

Attempting to modify Clark using Jai fails to remedy this deficiency. Jai teaches a system that resides on a computer operating system and essentially allows encrypted material to remain encrypted if it is to be delivered over a network, or be decrypted if it is required by an operating system component. Jai's system resides at a single critical data path in a computer operating system. Jai does not teach or suggest a system for processing separate databases of encrypted material and unencrypted material. Accordingly, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, nor is there a reasonable expectation of success.

Moreover, Jai specifically teaches away from the concept of an intermediate service provider that receives "an encrypted version of the private data and an unencrypted version of the public data." Jai explicitly states that the "apparatus utilized in this invention does not create any intermediate storage of decrypted material that is

under the protection of this technology." (See column 3, lines 24-27.) Accordingly, a person skilled in the art would clearly not be motivated to combine the two references.

Furthermore, there is clearly no teaching in either reference that allows a customer to "remain anonymous to the intermediary service provider," as recited in claims 3, 10, 14, and 18. The Examiner's position that Jai discloses this in abstract, Figure 1 and item 108 is clearly without merit, as Jai teaches away from an intermediary service provider; the abstract makes no mention of anonymity; and Figure 1 and item 108 do not show any mechanism for allowing a customer to remain anonymous.

Accordingly, Applicant respectfully submits that all claims are in condition for allowance. If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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